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OFFICE OF PETITIONS

In re Reissue Application of :
Seung-Cheol HONG et al. :
Application No. 09/942,961 : DECISION ON PETITION
Filed: August 31, 2001 : 37 CFR 1.181(a)(3)
Attorney Docket No. P54428RE :

This is a decision on the petition under 37 CFR 1.181(a)(3), filed May 30, 2003, to invoke the supervisory authority of the Director to direct the Director of Technology Center 2100 (Technology Center Director) to withdraw the finality of the Official action mailed April 2, 2003, in the above-identified reissue application.

The petition under 37 CFR 1.181(a)(3) filed May 30, 2003, to direct the Technology Center Director to withdraw the finality of the Official action mailed April 2, 2003, is DENIED.

BACKGROUND

The instant application, filed August 31, 2001, is an application for reissue of U.S. Patent No. 5,944,830, which issued from application No. 08/814,502.

On June 4, 2002, the examiner issued a non-final Office action (Paper No. 5). The Office action included (*inter alia*): (1) a rejection of claims 11, 12, 17, 18, 21, 22, 25, 26, 31, 32, 35, 38, 43, 46; 55, and 56 under 35 U.S.C. § 102(e) as being anticipated by Bang (5,870,086); (2) a rejection of claims 13-16, 19, 20, 23, 24, 27-30, 33, 34, 36, 37, 39-42, 44, 45, 47, 48, 57, 58, 59, and 60 under 35 U.S.C. § 103(a) as being unpatentable over Bang (5,870,086) in view of Applicants' admitted prior art (AAPA); and (3) an indication that claims 1-10 and 49-54 are allowable.

On September 4, 2002, petitioners filed a request for reconsideration (Paper No. 6) of (*inter alia*) the examiner's rejection of claims 11, 12, 17, 18, 21, 22, 25, 26, 31, 32, 35, 38, 43, 46, 55, and 56 under 35 U.S.C. § 102(e) as being anticipated by Bang (5,870,086) and the examiner's rejection of claims 13-16, 19, 20, 23, 24, 27-30, 33, 34, 36, 37, 39-42, 44, 45, 47, 48, 57, 58, 59, and 60 under 35 U.S.C. § 103(a) as being unpatentable over Bang (5,870,086) in view of Applicants' admitted prior art (AAPA). In particular, petitioners asserted that the reference to Bang (U.S. Patent No. 5,870,086), was not available as prior art because of the claim for foreign priority in the instant application.

On September 24, 2002, petitioners filed a supplemental request for reconsideration (Paper No. 9) restating arguments made of record in Paper No. 6, and additionally arguing that the related art set forth by the petitioners in the specification of the instant application is not an admission of prior art; therefore, the rejection of claims 13-16, 19, 20, 23, 24, 27-30, 33, 34, 36, 37, 39-42, 44, 45, 47, 48, 57, 58, 59, and 60 under 35 U.S.C. § 103(a) as being unpatentable over Bang (5,870,086) in view of Applicants' admitted prior art (AAPA) is improper.

On November 19, 2002, the examiner issued a second non-final Office action (Paper No. 10). The Office action included (*inter alia*): (1) a rejection of claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56 and 60 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of Heineman (5,465,366); (2) an indication that claims 1-10 and 49-54 are allowable; and (3) an indication that claims 34, 37, 39-41, 44, 45, 47, 48, and 57-59 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

On February 19, 2003, petitioners filed a request for reconsideration (Paper No. 11) of the rejection of claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56 and 60 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of Heineman (5,465,366). Petitioners again contended that the related art set forth in the instant specification is not an admission of prior art; therefore, the rejection of claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56 and 60 under 35 U.S.C. § 103(a) as being unpatentable over Heineman (5,465,366) in view of Applicants' admitted prior art (AAPA) is improper. Petitioners argued that the subject matter deemed to be "Applicants' Admitted Prior Art" is, in fact, the

applicants' own foundational work which should not, unless there is a statutory bar, be treated as prior art solely because knowledge of this work is admitted.

On April 2, 2003, the examiner issued a final Office action (Paper No. 12) finally rejecting claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56 and 60 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of Heineman (5,465,366). The Office action included an indication that claims 1-10 and 49-54 are allowable and an indication that claims 34, 37, 39-41, 44, 45, 47, 48, and 57-59 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

On May 12, 2003, petitioners filed a petition under 37 CFR 1.181 to the Technology Center Director (Paper no. 13) seeking review of the examiner's holding of finality in the Office action mailed April 2, 2003. Petitioners contended that the Examiner had not cited any evidence in his holding that portions of the instant specification constitute "prior art" and thus the Applicants had not had an opportunity to rebut the evidence; therefore, they "have not yet received the full cooperation from the Examiner regarding the issue of 'prior art'". Petitioners contended that paper no. 12 should have been a non-final Office action and request withdrawal of the finality of that Office action.

On May 28, 2003, the Technology Center Director issued a decision denying petitioners' request to withdraw the finality of the Office action (Paper No. 14) mailed April 2, 2003. The decision notes, in pertinent part, "the correctness of the art rejections is not subject to review by Petition."

On May 30, 2003, the instant petition (Paper No. 16) under 37 CFR 1.181(a)(3) was filed, seeking review of the Technology Center Director's decision denying the petition. A further request for consideration (Paper No. 15) was filed with the Examiner on the same date.

On June 17, 2003, the Examiner issued an Advisory Action (Paper No. 17) indicating entry of Applicants' arguments for purposes of appeal.

On July 2, 2003, a Notice of Appeal (Paper No. 18) from the Examiner's rejection of claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56 and 60 was filed.

STATUTE AND REGULATION

35 U.S.C. §132(a) provides, in part:

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

37 CFR 1.113 provides that:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an *inter partes* reexamination filed under § 1.913, see § 1.953.

OPINION

Petitioners assert that the Office action mailed April 2, 2003 (Paper No. 12) is a premature final Office action. Petitioners argue (*inter alia*) that: (1) The Examiner has not given the Applicants "full cooperation" on the issue of "prior art" because the Examiner has not cited evidence showing that Hong's Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 are "prior art" within the meaning of 35 U.S.C. §§ 102 and 103; (2) the Examiner has prematurely and incorrectly assumed that Applicants' Figure 1 is prior art; and (3) the Examiner has not cited any evidence that Hong's Figure 1, col. 1 at lines 23-35

and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 are "prior art", thus Applicants have not had the opportunity to rebut such evidence.

A review of the record of this application reveals that claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56 and 60 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of Heineman (5,465,366).

The rejection of claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56 and 60 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of Heineman (5,465,366) was first advanced by the examiner in the Office action mailed November 19, 2002. Petitioners filed a request for reconsideration of the examiner's holding of unpatentability of the claims on February 19, 2003. In the final Office action mailed April 2, 2003, the examiner finally rejected claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56 and 60 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of Heineman (5,465,366).

In specific regard to the finality of the Office action, and the assertion that the finality was premature:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

See Manual of Patent Examining Procedure 706.07(a) (8th ed. Rev. 1, Feb. 2003) (MPEP) (emphasis added).

Since the Office action of April 2, 2003 does not contain any new ground of rejection vis-a-vis the Office action of November 19, 2002, the Office action of April 2, 2002 was properly made final under MPEP 706.07(a)

With respect to petitioners' argument that they have not received the "full cooperation" of the examiner on the issue of "prior art", such an argument is unpersuasive. In particular, petitioners assert that because the examiner has not

presented any evidence on this issue, they have not had an opportunity to rebut such evidence. The final Office action, mailed April 2, 2003, at page 4, includes a response to petitioners' arguments on the issue of "prior art". The examiner's determination that the "Description of the Related Art" in the specification of the instant reissue application constitutes a prior art admission is based solely upon the statements contained in the specification of the instant reissue application. Thus, petitioners have been given a more than adequate opportunity to rebut the evidence that the examiner may rely upon in support of the position that the "Description of the Related Art" in the specification of the instant reissue application constitutes a prior art admission. Petitioners' argument concerning the need for additional evidence to support the position that the "Description of the Related Art" in the specification of the instant reissue application constitutes a prior art admission goes to the adequacy of the "AAPA" rejections (which is properly reviewable on appeal) rather than to the propriety of the finality of the Office action of April 2, 2003.

A review of the record also reveals that the Technology Center Director properly determined that the issues presented in the petition of November 1, 2001 are primarily directed to issues properly reviewable by the Board of Patent Appeals and Interferences (BPAI) on appeal, and are not properly reviewable on petition. See 37 CFR 1.181(a) (Petition may be taken . . . [f]rom any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court).

The line of demarcation between appealable matters for the BPAI and petitionable matters for the Director is carefully observed. See MPEP 1201. The BPAI will not ordinarily hear a question which it believes should be decided by the Director, and the Director will not ordinarily entertain a petition where the question presented is an appealable matter. See id. In exercising supervisory authority under 37 CFR 1.181, the Director will not usurp the functions or impinge upon the jurisdiction of the BPAI. See In re Dickinson, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962).

In specific regard to whether a claim or claims are patentable over a portion of applicants' specification deemed to constitute "prior art" is reviewable by petition to the Director or by an appeal to the BPAI:

The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board

of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the Commissioner. Similarly, the Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board. These formal matters should not be combined in appeals to the Board.

See MPEP 706.01 (emphasis added); see also MPEP 706.07(c) (Any question as to prematurity of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection).

Under certain circumstances, an applicant's representations in his or her application may constitute an admission that may be considered "prior art" for any purpose, including use as evidence of obviousness under 35 U.S.C. § 103. See In re Garfinkel, 437 F.2d 1000, 1004, 168 USPQ 659, 662 (CCPA 1971); In re Hellsund, 474 F.2d 1307, 1311, 177 USPQ 170, 173 (CCPA 1973); In re Nomiya, 509 F.2d 566, 184 USPQ 607, 611 (CCPA 1975). Thus, the examiner's use of the "Description of the Related Art" in the specification of the instant reissue application as a prior art admission in the rejection of claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56 and 60 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of Heineman (5,465,366) is, from a procedural prospective, appropriate. The substantive issue of whether the "Description of the Related Art" in the specification of the instant reissue application constitutes a prior art admission which renders claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56 and 60 under 35 U.S.C. § 103(a) unpatentable under 35 U.S.C. §§ 102 and 103 is an issue that is properly reviewable by way of an appeal of the rejected claims, and is not properly reviewable by way of a petition under 37 CFR 1.181(a).

There is no dispute that the claims have been twice-rejected on the same grounds. Since a clear issue has been developed between the examiner and applicants in this application, the applicants are now in a position to judge the advisability of an appeal.

CONCLUSION

For the above-stated reasons, the Technology Center Director has provided a reasonable basis to support his findings and conclusion that the finality of the

Office action of April 2, 2003 is proper. Therefore, the Technology Center Director did not abuse his discretion in denying the petition to withdraw the finality of the Office action of April 2, 2003. The instant petition is granted to the extent that the Technology Center Director's Decision of May 28, 2003 has been reviewed, but is **denied** with respect to directing the Technology Center Director to withdraw the finality of the Office action of April 2, 2003.

This decision refusing to direct the Technology Center Director to withdraw the finality of the Office action mailed April 2, 2003 may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1001.02.

The file of the above-identified reissue application is being forwarded to Technology Center Art Unit 2181 for treatment of petitioners' brief on appeal.

Telephone inquiries concerning this matter may be directed to Senior Petitions Examiner Brian Hearn at (703) 305-1820 or, in his absence, to B. Dayoan at (703) 308-3865.

A handwritten signature in black ink, appearing to read "Stephen G. Kunin". The signature is fluid and cursive, with the first name "Stephen" and last name "Kunin" clearly distinguishable.

Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy

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